

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Dunkley et al.	Group Art Unit: 3771
Application No: 10/821,624 Confirmation No: 8935	Examiner: Matter, Kristen Clarette
Filed: April 9, 2004	Attorney Docket No: 53315-US-CNT (NK.197.00)
Title: AEROSOLIZATION APPARATUS WITH CAPSULE PUNCTURE ALIGNMENT GUIDE	May 4, 2009 San Francisco, California 94107

REPLY BRIEF

VIA ELECTRONIC FILING

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Examiner:

In response to the Examiner's Answer mailed on March 4, 2009, the Applicant of the above-referenced patent application (hereinafter Appellant) hereby maintains the appeal to the Board of Patent Appeals and Interferences. Appellant requests the reversal of the Final Rejection.

Certificate of Transmission

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, facsimile transmitted to the U.S. Patent and Trademark Office at (571) 273-8300, or electronically submitted via EFS on the date shown below:

By: Melanie Hitchcock
Melanie Hitchcock

Date: May 4, 2009

Status of Claims

Claims 20-28, 31 and 32 are presently pending in the case. Claims 1-19, 29, 30, 33 and 34 have been cancelled. Claims 21-26 are withdrawn from consideration until such time as the generic claim from which they depend is determined to be allowable. Claims 20, 27, 28, 31 and 32 have been finally rejected. The appeal of the rejection of each of claims 20, 27, 28, 31 and 32 is hereby maintained.

Grounds of Rejection to be Reviewed on Appeal

Appellant continues to request review of the Examiner's following grounds of rejection:

Claims 20, 27 and 28 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 4,069,819 to Valentini et al (hereinafter Valentini et al).

Claims 31 and 32 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Valentini et al in view of U.S. Patent Application US 2003/0000523 to Citterio (hereinafter Citterio).

Argument

Appellant believes each of claims 20, 27, 28, 31 and 32 is improperly rejected and is therefore allowable for the reasons set forth in Appellant's Appeal Brief filed on May 14, 2008. The present Reply Brief is being filed to specifically address some of the issues raised by the Examiner in the Examiner's Answer mailed on March 4, 2009. The comments herein are merely supplemental to the arguments made in the Appeal Brief and are not meant to replace those arguments.

Valentini et al does not have a contact surface comprising protrusions

Valentini et al does not anticipate independent claim 20 for the reasons described in the Appeal Brief. For example, claim 20 is to an aerosolization apparatus comprising, inter alia, an alignment guide having a surface adapted to contact a capsule while a puncture member is advanced into the capsule, and wherein the surface comprises one or more protrusions for contacting the capsule. This positively recited feature is not disclosed by Valentini et al. The angled contact surface at the end of element L of Valentini et al contains no protrusions. Since Valentini et al does not disclose each and every feature set forth in claim 20, it does not anticipate the claim.

The Examiner's comments in the Examiner's Answer do not serve to establish Valentini et al as an anticipatory reference with regard to claim 20. The Examiner seems to be taking the position that the entire forward end of the contact surface can be considered to be a protrusion that extends from some arbitrary surface. However, this continues to be an improper distortion of the reference, as will be discussed.

Claim 20 clearly and positively recites "a surface" and "wherein the surface comprises one or more protrusions." Thus, a reference would need both a surface and one or more protrusions in order to be properly anticipatory. In other words, a surface with a protrusion can not be anticipated by merely the protrusion. Valentini et al lacks the combination of a surface and a protrusion. Valentini et al discloses only a contact

surface and does not disclose protrusions. One of ordinary skill in the art would not look at Valentini's flat contact surface and find it to be a contact surface with protrusions for contacting the capsule. Appellants show an example of a surface with protrusions in Figure 4 (as discussed on page 11 lines 19-30 of Appellant's specification). Appellants do not consider the disclosed contact surfaces (133) in the versions shown in Figures 1A-E and 2A-2E to be contact surfaces comprising protrusions, nor would one of ordinary skill in the art find them to be.

The Examiner's finding of both a surface and a protrusion is without merit (see page 7 lines 1-3). To the Examiner, Valentini et al discloses a "surface" at either (i) an arbitrary horizontal surface underneath the blackened portion of the Examiner's altered drawing on page 7 of the Examiner's Answer or (ii) the remaining part of the angled surface below the blackened part. For (i), Appellant can find no such horizontal surface. One of ordinary skill in the art would not find any arbitrary horizontal surface in Valentini et al that could be considered a surface, much less a contact surface as claimed. As for (ii), the Examiner is, in essence, saying one half of a flat surface is a "surface" and the other half of the flat surface is a "protrusion" from the first half. This is not a fair interpretation and is not one that would be made by one of ordinary skill in the art.

In sum, Appellant has described contact surfaces without protrusions (as shown for example in Figures 1A-1E) and with protrusions (as shown for example in Figure 4), and in the presently pending claim 20 Appellant has limited the scope to encompass only those with protrusions. One of ordinary skill in the art would recognize that the scope of claim 20 does not include contact surfaces without protrusions. The Examiner's word and reference distortion notwithstanding, the application of a contact surface without protrusions as an anticipatory reference against a claim which is clearly limited to a contact surface with protrusions is an improper application.

Appellant continues to request reversal of the rejection of claim 20 under 35 U.S.C. §102(b). Appellant also continues to request reversal of the balance of the rejections for the reasons set forth in the Appeal Brief.

Conclusion

Thus, it is believed that all rejections made by the Examiner have been addressed and overcome by the above arguments and the arguments provided in the Appeal Brief. Therefore, all pending claims are allowable. A reversal is respectfully requested.

Should there be any questions, Appellant's representative may be reached at the number listed below.

Respectfully submitted,

JANAH & ASSOCIATES

Dated: May 4, 2009

By: 

Guy V. Tucker
Reg. No. 45,302

Please send all correspondence to:
Guy Tucker
Janah & Associates
650 Delancey Street, Suite 106
San Francisco, CA 94107
Phone: (415) 538-1555
Fax: (415) 538-8380